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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/909,015 | 07/20/2001 | Kazuhiro Sugawara | 35.C15592 | 9096 |
| 5514 | 7590 | 10/18/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | ARTHUR JEANGLAUDE, GERTRUDE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2144 | |

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/909,015 | SUGAWARA, KAZUHIRO | |
| | Examiner | Art Unit | |
| | Gertrude Arthur-Jeanglaude | 3661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>13004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-8, 16-17, 20, 22, are rejected under 35 U.S.C. 102(b) as being anticipated by Chalmers et al. (WO 99/14909).

As to claims 7, 16, Chalmers et al. discloses a communicating apparatus comprising obtaining means for obtaining size information of each of a plurality of E-mails stored in a mail box provided on an E-mail server (See Fig.3, # 303, 304, 321, 330; Fig.4); selecting means for selecting the receivable E-mail on the basis of the size information obtained by the obtaining means; and receiving means for receiving the E-mail selected by the selecting means from the E-mail server (See abstract; Fig.4).

As to claims 8, 17 Chalmers et al. disclose in Figs.3-4 the selecting means compares a maximum value of a size of one E-mail which has previously been stored with the size information obtained by the obtaining means, thereby discriminating whether the e-mail is receivable or not.

As to claim 20, Chalmers et al. disclose a computer program (See page 15, lines 19-30) which is executed by a computer of an information processing apparatus having a communication function comprising obtaining means for obtaining size information

Art Unit: 3661

of each of a plurality of E-mails stored in a mail box provided on an E-mail server (See Fig.3, # 303, 304, 321, 330; Fig.4); selecting means for selecting the receivable E-mail on the basis of the size information obtained by the obtaining means; and receiving means for receiving the E-mail selected by the selecting means from the E-mail server (See abstract; Fig.4).

As to claim 22, Chalmers et al. disclose a computer readable memory medium 6 that stores a computer program.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-15, 18-19, 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chalmers et al. (WO 99/14909) in view of Geiger et al. (US 6073142).

As to claims 1, 10, Chalmers et al. disclose a communicating apparatus comprising receiving means for receiving E-mails stored in a mail box (5) as shown in Fig.1 provided on an E-mail server; obtaining means for obtaining a size of an E-mail stored in the mail box; memory means (6) for storing a maximum value of the size of one E-mail which is received by the receiving means; discriminating means (considered as message filter 2 in Fig. 1) for comparing the E- mail obtained by the obtaining means

Art Unit: 3661

with the maximum value, thereby discriminating whether the E-mail is receivable or not; (also see Fig. 5; # 520, 530, 531, 540, 541) and obviously a control means for sending an instruction for deleting (selecting part of a message) the E-mail which was determined to be unreceivable by the discriminating means to the E-mail server and storing the fact that the E-mail has been deleted into a communication history (See abstract). Though Chalmers et al. disclose a discriminating means (message filter) capable of processing the total size of a message; and comparing the size of the E-mail (See page 6, lines 5-25); it does not specifically disclose deleting the E-mail that is unreceivable. In an analogous art, Geiger et al. disclose a communicating apparatus wherein the size of the E-mail is compared and deleting E-mail (See col.3, lines 3, lines 23-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Chalmers et al. with that of Geiger et al. by having a size of an E-mail and delete the email that is unreceivable in order to better direct E-mails.

As to claims 2, 4, 11-12 Chalmers et al. disclose as shown in Fig. 2 a header information of the E-mail whereas it is considered that the E-mail was determined to be unreceivable and receivable by the discriminating means (as the message filter may select the whole or a part of the message and arrange for the storage of the selected part in a store 6) (See abstract).

As to claims 3, 5, 6, 13-15, Chalmers et al. disclose the discriminating means as discussed and a stored means 6 wherein it would have been obvious to store the size information of the e-mail which was determined to be unreceivable by the discriminating

Art Unit: 3661

means into the communication history. Also Chalmers disclose a mailbox 5 as shown in Fig. 1 for storing e-mails. Moreover, Chalmers et al. disclose the control means as discussed that allows recording means (storing) to record the E-mail (See page 3, lines 19-25).

As to claims 9, 18 Chalmers et al. disclose the email but not specifically disclose deletion instructing means for sending an instruction for deleting the e-mails. In an analogous art, Geiger et al. disclose the deleting of e-mails (See col.3, lines 3, lines 23-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Chalmers et al. with that of Geiger et al. by having a size of an E-mail and delete the email that is unreceivable in order to better direct E-mails.

As to claim 19, Chalmers et al. disclose a computer program (See page 15, lines 19-30) which is executed by a computer of an information processing apparatus having a communication function comprising receiving means for receiving E-mails stored in a mail box (5) as shown in Fig.1 provided on an E-mail server; obtaining means for obtaining a size of an E-mail stored in the mail box; memory means (6) for storing a maximum value of the size of one E-mail which is received by the receiving means; discriminating means (considered as message filter 2 in Fig. 1) for comparing the E-mail obtained by the obtaining means with the maximum value, thereby discriminating whether the E-mail is receivable or not; (also see Fig. 5; # 520, 530, 531, 540, 541) and obviously a control means for sending an instruction for deleting (selecting part of a message) the E-mail which was determined to be unreceivable by the discriminating

Art Unit: 3661

means to the E-mail server and storing the fact that the E-mail has been deleted into a communication history (See abstract). Though Chalmers et al. disclose a discriminating means (message filter) capable of processing the total size of a message; and comparing the size of the E-mail (See page 6, lines 5-25); it does not specifically disclose deleting the E-mail that is unreceivable. In an analogous art, Geiger et al. disclose a communicating apparatus wherein the size of the E-mail is compared and deleting E-mail (See col.3, lines 3, lines 23-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Chalmers et al. with that of Geiger et al. by having a size of an E-mail and delete the email that is unreceivable in order to better direct E-mails.

As to claim 21, Chalmers et al. disclose a computer readable memory medium 6 that stores a computer program.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sherman et al. (US 6647409) disclose maintaining a sliding view of server based data on a handheld personal computer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gertrude Arthur-Jeanglaude whose telephone number is

Art Unit: 3661

(703) 308-7564. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (703) 305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GAJ

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October 4, 2004

Gertrude A. Jeanglaude
GERTRUDE A. JEANGLAUDE
PRIMARY EXAMINER